REMARKS

Claims 1-35 are pending. In the August 16, 2004 Office Action Claims 6, 9-12, 28, 30, 31, and 33 were rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,539,077 to Ranalli et al. (hereinafter, Ranalli). Claims 1-5, 7, 8, 13-27, 29, 32, 34, and 35 were rejected under 35 USC §103(a) as being unpatentable over Ranalli in view of U.S. Patent No. 6,182,148 to Tout et al. (hereinafter, Tout). In addition, the Examiner objected to the specification.

Discussion of the objection to the specification

The Examiner objected to Claim 22 because the claim was missing the word "top" before the phrase "level domain (TLD)". In response, Applicant has amended Claim 22 to recited "top level domain (TLD)". Applicant therefore respectfully requests that the Examiner withdraw the objection to the specification.

Discussion of the rejections under 35 USC §102(e)

To anticipate a claim, the reference must teach every element of the claim. *See* MPEP § 2131 at 2100-70. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See id.* (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)) (emphasis added).

Because Ranalli does not disclose, expressly or inherently, each claim element of independent Claim 6, Applicant respectfully submits that Claim 6 is allowable over Ranalli. For example, a careful review of Ranalli completely fails to disclose:

> *a first instruction configured to determine whether a first RFC 1035 compliant address has a non-standard TLD belonging to a first set of non-standard TLD names*

Indeed, the citation provided by the Examiner (Ranalli, column 13, lines 27-28) fails to even discuss making a determination, much less a determination as to whether an address has a non-standard TLD belonging to a first set of non-standard TLD names. Instead, column 13, lines 27-28, merely recites: 'The resulting DS domain name address becomes: "2.1.2.1.5.5.5.0.0.8.1.tel". Alternatively, the DS would also accept the format: "8005551212.1.tel".'

Further, careful review of Ranalli completely fails to disclose:

> *a second instruction configured to append an extension, including at least a standard TLD, to the first RFC 1035 compliant address at least partly in response to the first*

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instruction determining that the first address has a non-standard TLD belonging to the first set of non-standard TLD names

Indeed, the Examiner failed to provide a citation to Ranalli that discloses the foregoing element, and no such citation exists in Ranalli. Instead, Ranalli discloses that "a tractable system to enable translation of an E.164 telephone number with DS software requires the creation of a new name space or domain on the Internet. Ideally this would be a new generic top-level domain called ".tel" (i.e., the equivalent of .com or .gov). The Internet Corporation for Assignment of Names and Numbers (ICANN) controls the assignment of Root Domain Servers and the Generic Top Level Domains ... ICANN, accessible via the Internet at www.icann.org, can be petitioned to adopt tel as an additional generic top level domain." Column 12, lines 59-67. Thus, rather than disclosing appending an extension, including at least a standard TLD, to an RFC 1035 compliant address at least partly in response to determining that a first address has a non-standard TLD, Ranalli requires the creation of a new generic top-level domain called ".tel" by ICANN, which would then be ICANN compliant, which does not appear to be appended to a non-standard top level domain.

Further, as an alternative, Ranalli discloses requiring using a sub-domain within the existing ICANN compliant top level domain. *See*, column 13, lines 13-16. However, Ranalli does not disclose determining whether a first RFC 1035 compliant address has a non-standard TLD belonging to a first set of non-standard TLD names, or, at least partly in response to making such a determination, appending a standard top level domain to the non-standard top level domain.

The Examiner takes the position that the Ranalli teaches "that the invention has an ability to dynamically append the generic top level domain identifier to the request, line 26-27. Thus, the reference teaches the method to create a non-ICANN compliant TLD ".tel" be appended by any of the ICANN compliant TLDs to resolve the IP address." However, the citation at column 13, lines 26-27 referred to by the Examiner discloses that Ranalli "appends the ".tel" generic top level domain identifier," wherein the ".tel" would be a generic top level domain approved by ICANN. Ranalli nowhere discloses appending an ICANN compliant top level domain to a non-ICANN compliant ".tel" top level domain as asserted by the Examiner.

Indeed, nowhere does Ranalli disclose determining whether an address has a non-standard top level domain, and at least partly in response, appending an ICANN compliant top level

domain, much less "a second instruction configured to append an extension, including at least a standard TLD, to the first RFC 1035 compliant address at least partly in response to the first instruction determining that the first address has a non-standard TLD belonging to the first set of non-standard TLD names" as claimed. As discussed above, a claim is anticipated <u>only if each and every</u> element as set forth in the claim is found, either <u>expressly</u> or <u>inherently described</u>, in a single prior art reference. With respect to Claim 6, claim elements are present that are neither expressly or inherently described in Ranalli.

Because Ranalli does not expressly or inherently describe elements in Claim 6, Applicant respectfully submits that Claim 6 is allowable and requests that the Examiner withdraw the rejection and allow Claim 6.

With respect to Claim 28, because Ranalli does not disclose, expressly or inherently, each claim element of independent Claim 28, Applicant respectfully submits that Claim 28 is allowable over Ranalli.

For example, Ranalli fails to disclose:

> *a first instruction configured to determine whether a first email address for an email being dispatched by a sender contains a non-ICANN compliant TLD name, wherein the first email address is associated with an intended email recipient;*

or

> *a second instruction configured to form a second email address by appending an extension including at least an ICANN compliant TLD name to the first email address at least partly in response to a determination by the first instruction that the first email address contains a non-ICANN compliant TLD name.*

While the Examiner takes the position that Ranalli discloses the foregoing elements at column 3, lines 5-25 and column 13, lines 17-30, Applicant respectfully traverses the Examiner's characterization of Ranalli. For example, Ranalli, at column 3, lines 5-25 fails to even disclose that an email address can contain a non-ICANN compliant TLD name. Indeed, the only mention of domains in column 3, lines 5-25 is the following: "Each of these systems may contact the directory service using one or more different protocols, such as Lightweight Directory Access Protocol (LDAP) or Domain Name System (DNS), to resolve the registered unique identifier to an associated Internet address." Further, column 13, lines 17-30, fails to even mention a first instruction configured to determine whether a first email address contains a non-ICANN compliant top level domain name, or a second instruction configured to form a second email address by appending an extension including at least an ICANN compliant top level domain

name to the first email address at least partly in response to the determination by the first instruction, much less the invention as claimed.

As similarly discussed with respect to Claim 6, Ranalli requires that in order for ".tel" to be used as a generic top level domain, ICANN must approve ".tel" as a generic top level domain name. Further, as an alternative, Ranalli discloses requiring using a sub-domain within the existing ICANN compliant top level domain. *See*, column 13, lines 13-16. Ranalli does not disclose a first instruction configured to determine whether a first email address for an email being dispatched by a sender contains a non-ICANN compliant TLD name as claimed. Ranalli further does not disclose a second instruction configured to form a second email address by appending an extension including at least an ICANN compliant TLD name to the first email address at least partly in response to a determination by the first instruction that the first email address contains a non-ICANN compliant TLD name as claimed.

Because Ranalli does not expressly or inherently describe elements in Claim 28, Applicant respectfully submits that Claim 28 is allowable and requests that the Examiner withdraw the rejection and allow Claim 28.

With respect to Claim 31, because Ranalli does not disclose, expressly or inherently, each claim element of independent Claim 31, Applicant respectfully submits that Claim 31 is allowable over Ranalli.

For example, Ranalli fails to disclose:

> *a second instruction configured to form a second email address by removing for display the predetermined domain*

While the Examiner takes the position that Ranalli, at column 2, lines 44-54, discloses the foregoing element, this citation merely discloses:

> In a preferred embodiment, the unique identifier is a telephone number, as provided by the PSTN. The data network may take the form of the commonly available Internet. The directory service would thus provide resolution of the telephone number of an intended recipient, to an associated Internet address for the intended recipient. The directory may also contain other information which may be useful in setting up a communication link between users. Such other information may also include particular requirements of the destination system, for example, the required format of a communication.

Nowhere does this citation disclose "a second instruction configured to form a second email address by removing for display the predetermined domain." Indeed, Ranalli does not

even disclose removing an address domain when displaying an email address. Because Ranalli does not expressly or inherently describe elements in Claim 31, Applicant respectfully submits that Claim 31 is allowable and requests that the Examiner withdraw the rejection and allow Claim 31.

Discussion of the rejections under 35 USC §103(a)

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. In this case, the combination of Ranalli and Tout fail to satisfy this basic requirement.

For example, with respect to Claim 1, while the Examiner takes the position that Ranalli discloses, at column 13, lines 27-28:

> *receiving from a user's client terminal data corresponding to a first Internet address utilizing only RFC 1035 compliant characters, the first Internet address including a non-ICANN compliant TLD, at a user's Internet Service Provider's (ISP) domain name system server (DNS server);*

However, as similarly discussed above with respect to Claim 6, Ranalli requires that in order for ".tel" to be used as a generic top level domain, ICANN must approve ".tel" as a generic top level domain name, and hence, ".tel" would be ICANN compliant. *See* Ranalli, column 12, line 59, to column 13, line 16. Further, as an alternative, Ranalli discloses requiring using a sub-domain within the existing ICANN compliant top level domain. *See*, column 13, lines 13-16. Ranalli does not disclose receiving a "first Internet address including a non-ICANN compliant TLD" and appending "an extension, including at least an ICANN compliant TLD, to the first Internet address" as asserted by the Examiner.

Further, Ranalli fails to disclose or suggest "receiving at the user's client terminal a negative response from the ISP DNS server in response to receiving the data corresponding to the first Internet address," as asserted by the Examiner. The Examiner takes the position that Ranalli discloses using a first internet address "2.1.2.1.5.5.5.0.0.8.1.tel" including the top level domain ".tel", which "will produce the negative result which is also well known in the art." However, Ranalli only discloses using ".tel" as a top level domain name if ICANN approved ".tel" as a top level domain name, and so the use of ".tel" as disclosed by Ranalli would not produce "the negative result" as asserted by the Examiner. Similarly, Ranalli discloses using a sub-domain

within the existing ICANN compliant top level domain, the use of which would also fail to produce a negative response.

Thus, even if Ranalli were modified with the disclosure of Tout as proposed by the Examiner, the combination would not provide the invention as claimed.

Still further, the Examiner has failed to provide an adequate motivation to modify Ranalli with the disclosure of Tout. While the Examiner admits that Ranalli fails to disclose receiving a first internet address at an address converter system executing on the user's client terminal, the Examiner proposes modifying Ranalli by installing Tout's transformation logic on the user's client terminal.

The only motivation provided by the Examiner for such a modification is that such a modification will "eliminate the current problems faced by the communication system as explained by Ranalli in col. 2, lines 15-20." However, Ranalli at column 2, lines 15-20, is referring to problems with conventional systems that Ranalli is directed to overcoming, not to problems with the apparatus and methods disclosed by Ranalli. In particular, Ranalli recites "In summary, the restricted addressing capability of a local directory severely circumscribes the utility of these new IP-enabled communication systems. The limited information contained in such local directories results in many call diversions to the PSTN, and further, increased administration costs associated with maintaining local databases." The methods and apparatus of Ranalli appear intended to overcome such problems, and Ranalli is not stating that Ranalli's apparatus and methods suffer from such problems.

Further, the Examiner has not provided any explanation as to how installing Tout's transformation logic on the user's client terminal in Ranalli would eliminate any problems with the communication system of Ranalli.

Because, whether analyzed alone or in combination, Ranalli and Tout fail to teach or suggest all the claimed elements, and because there would be no motivation to modify Ranalli with the disclosure of Tout as proposed by the Examiner, the Examiner has failed to make a prima facie case of obviousness. Applicant therefore respectfully requests the Examiner to withdraw the rejection to Claim 1 under 35 U.S.C. § 103(a).

With respect to Claim 13, Ranalli fails to disclose or suggest receiving a first Internet address having a non-standard TLD, determining that the first Internet address's non-standard TLD is in a first set of non-standard TLDs, and upon determining that the first Internet address's

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non-standard TLD is in the first set of non-standard TLDs, adding an extension, much less the invention as claimed.

Instead, Ranalli simply discloses that in order for ".tel" to be used as a generic top level domain, ICANN must approve ".tel" as a generic top level domain name, and hence, ".tel" would be ICANN compliant. *See* Ranalli, column 12, line 59, to column 13, line 16. Further, as an alternative, Ranalli discloses requiring using a sub-domain within the existing ICANN compliant top level domain. *See*, column 13, lines 13-16.

Ranalli fails to teach or suggest "upon determining that the first Internet address's non-standard TLD is in the first set of non-standard TLDs, adding an extension, including at least a predetermined standard TLD, to the first Internet address to create a modified first Internet address," as argued by the Examiner. Nowhere does Ranalli disclose determining that a first Internet address's non-standard TLD is in a first set of non-standard TLDs, and that upon making such a determination, adding an extension, including at least a predetermined standard TLD.

Yet further, Ranalli, which fails to even mention a proxy server, fails to teach or suggest "providing data corresponding to the modified first Internet address to a proxy server, so that the proxy server can provide the modified first Internet address to a domain name system server," as claimed. Indeed, the Examiner has failed to provide any citation to Ranalli that teaches or suggests providing data corresponding to a modified Internet address to a proxy server, so that the proxy server can provide the modified Internet address to a domain name system server.

In addition, the Examiner admits that Ranalli fails to disclose "receiving at the LSP a first Internet address having a non-standard TLD, wherein the LSP determines that the first Internet address's non-standard TLD is in a first set of non-standard TLDs," as claimed. Nonetheless, the Examiner relies on Tout to provide the missing element.

The only motivation provided by the Examiner for such a modification is that such a modification will "eliminate the current problems faced by the communication system as explained by Ranalli in col. 2, lines 15-20." However, as similarly discussed with respect to Claim 1, Ranalli at column 2, lines 15-20, is referring to problems with conventional systems that Ranalli is directed to overcoming, not to problems with the apparatus and methods disclosed by Ranalli. In particular, Ranalli recites "In summary, the restricted addressing capability of a local directory severely circumscribes the utility of these new IP-enabled communication systems. The limited information contained in such local directories results in many call diversions to the

PSTN, and further, increased administration costs associated with maintaining local databases." The method and apparatus of Ranalli appear intended to overcome such problems, rather than suffering from such problems. Because the Examiner has failed to provide any support for the statement that modifying Ranalli with the LDP of Tout would solve "problems faced by the communication system," of Ranalli, the Examiner has failed to provide an adequate motivation to modify Ranalli with the disclosure of Tout.

Because, whether analyzed alone or in combination, Ranalli and Tout fail to teach or suggest all the claimed elements, and because there would be no motivation to modify Ranalli with the disclosure of Tout as proposed by the Examiner, the Examiner has failed to make a prima facie case of obviousness. Applicant therefore respectfully requests the Examiner to withdraw the rejection to Claim 13 under 35 U.S.C. § 103(a).

With respect to Claim 16, the Examiner appears to take the position that Ranalli discloses receiving email having a first recipient email address with a non-standard TLD, and adding an extension, the extension including a standard TLD, to the recipient's first email address to generate a modified recipient email address. Applicant respectfully traverses the Examiner's characterization of Ranalli. As similarly discussed above, Ranalli fails to disclose or suggest receiving an email having a first recipient email address with a non-standard top level domain, and then adding an extension including a standard top level domain to the recipient's first email address, much less the invention as claimed.

Ranalli simply discloses that in order for ".tel" to be used as a generic top level domain, ICANN must approve ".tel" as a generic top level domain name, and hence, ".tel" would be ICANN compliant. *See* Ranalli, column 12, line 59, to column 13, line 16. Further, as an alternative, Ranalli discloses requiring using a sub-domain within the existing ICANN compliant top level domain. *See*, column 13, lines 13-16. Ranalli does not disclose or suggest receiving an email having a first recipient email address with a non-standard top level domain, and then adding an extension including a standard top level domain to the recipient's first email address.

In addition, the Examiner appears to admit that Ranalli fails to disclose either "using a Layered Service Provider (LSP)", or intercepting "on a sender's client system," email having a first recipient email address with a non-standard TLD. The Examiner further appears to admit that Ranalli fails to disclose "adding, via the LSP, an extension." Nonetheless, the Examiner relies on Tout to provide the missing element.

The only motivation provided by the Examiner for such a modification is that such a modification will "eliminate the current problems faced by the communication system as explained by Ranalli in col. 2, lines 15-20." However, as similarly discussed with respect to Claim 1, Ranalli at column 2, lines 15-20, is referring to problems with conventional systems that Ranalli is directed to overcoming, not to problems with the apparatus and methods disclosed by Ranalli. In particular, Ranalli recites "In summary, the restricted addressing capability of a local directory severely circumscribes the utility of these new IP-enabled communication systems. The limited information contained in such local directories results in many call diversions to the PSTN, and further, increased administration costs associated with maintaining local databases." As previously discussed, the methods and apparatus of Ranalli appear intended to overcome such problems, rather than suffer from such problems. Because the Examiner has failed to provide any support for the statement that modifying Ranalli with Tout would solve "problems faced by the communication system" of Ranalli, the Examiner has failed to provide an adequate motivation to modify Ranalli with the disclosure of Tout.

Because, whether analyzed alone or in combination, Ranalli and Tout fail to teach or suggest all the claimed elements of Claim 16, and because there would be no motivation to modify Ranalli with the disclosure of Tout as proposed by the Examiner, the Examiner has failed to make a prima facie case of obviousness. Applicant therefore respectfully requests the Examiner to withdraw the rejection to Claim 16 under 35 U.S.C. § 103(a).

With respect to Claim 22, Ranalli fails to teach or suggest, by way of example, making a determination as to whether a first email address contains a non-ICANN compliant TLD name. Further, the Examiner has failed to provide any citation to Ranalli wherein such a determination is made. Ranalli therefore further fails to teach or suggest appending at least an ICANN compliant TLD to the first email address "at least partly in response to determining that the email address contains a non-ICANN compliant TLD name."

Additionally, the Examiner admits that Ranalli fails to disclose determining "on a sender's client system" whether a first email address contains a non-ICANN compliant TLD name. Nonetheless, the Examiner relies on Tout to provide the missing element.

The only motivation provided by the Examiner for such a modification is that such a modification will "eliminate the current problems faced by the communication system as explained by Ranalli in col. 2, lines 15-20." However, as similarly discussed with respect to

Claim 1, Ranalli at column 2, lines 15-20, is referring to problems with conventional systems that Ranalli is directed to overcoming, not to problems with the apparatus and methods disclosed by Ranalli. In particular, Ranalli recites "In summary, the restricted addressing capability of a local directory severely circumscribes the utility of these new IP-enabled communication systems. The limited information contained in such local directories results in many call diversions to the PSTN, and further, increased administration costs associated with maintaining local databases." The method and apparatus of Ranalli appear intended to overcome such problems, rather than suffering from such problems, and therefore the Examiner has failed to provide an adequate motivation to modify Ranalli with the disclosure of Tout.

Further, the Examiner has not provided any explanation as to how installing Tout's LSP on the user's client terminal in Ranalli to filter email addresses would eliminate any problems with the communication system of Ranalli, or what those problems are.

Because, whether analyzed alone or in combination, Ranalli and Tout fail to teach or suggest all the claimed elements, and because there would be no motivation to modify Ranalli with the disclosure of Tout as proposed by the Examiner, the Examiner has failed to make a prima facie case of obviousness. Applicant therefore respectfully requests the Examiner to withdraw the rejection to Claim 22 under 35 U.S.C. § 103(a).

With respect to Claim 35, the Examiner appears to take the position that Ranalli discloses identifying a first Internet address having a non-standard TLD, determining that the first Internet address's non-standard TLD is in a first set of non-standard TLDs, and adding an extension, including at least a predetermined standard TLD, to the first Internet address to create a modified first Internet address. However, the citations provided by the Examiner fail to disclose or suggest identifying a first Internet address having a non-standard TLD and determining that the first Internet address's non-standard TLD is in a first set of non-standard TLDs.

Ranalli discloses that:

> "a tractable system to enable translation of an E.164 telephone number with DS software requires the creation of a new name space or domain on the Internet. Ideally this would be a new generic top-level domain called ".tel" (i.e., the equivalent of .com or .gov). The Internet Corporation for Assignment of Names and Numbers (ICANN) controls the assignment of Root Domain Servers and the Generic Top Level Domains ... ICANN, accessible via the Internet at www.icann.org, can be petitioned to adopt tel as an additional generic top level domain." Column 12, lines 59-67.

Thus, rather than disclosing appending an extension, including at least a standard TLD, to an RFC 1035 compliant address at least partly in response to determining that a first address has a non-standard TLD, Ranalli requires the creation of a new generic top-level domain called ".tel" by ICANN, which would then be ICANN compliant.

Further, as an alternative, Ranalli discloses requiring using a sub-domain within the existing ICANN compliant top level domain. *See,* column 13, lines 13-16. However, Ranalli does not disclose identifying a first Internet address having a non-standard TLD and determining that the first Internet address's non-standard TLD is in a first set of non-standard TLDs, and then appending a standard top level domain to the non-standard top level domain in response to the determination, much less disclose or suggest the invention as claimed.

Still further, the Examiner admits that Ranalli fails to disclose using a Layered Service Provider (LSP). Nonetheless, the Examiner relies on Tout to provide the missing element.

The only motivation provided by the Examiner for such a modification is that such a modification will "eliminate the current problems faced by the communication system as explained by Ranalli in col. 2, lines 15-20." However, as similarly discussed with respect to Claim 1, Ranalli at column 2, lines 15-20, is referring to problems with conventional systems that Ranalli is directed to overcoming, not to problems with the apparatus and methods disclosed by Ranalli. In particular, Ranalli recites "In summary, the restricted addressing capability of a local directory severely circumscribes the utility of these new IP-enabled communication systems. The limited information contained in such local directories results in many call diversions to the PSTN, and further, increased administration costs associated with maintaining local databases." The method and apparatus of Ranalli appear intended to overcome such problems, rather than suffering from such problems, and therefore the Examiner has failed to provide an adequate motivation to modify Ranalli with the disclosure of Tout.

Further, the Examiner has not provided any explanation as to how installing Tout's LSP on the user's client terminal in Ranalli to filter email addresses would eliminate any problems with the communication system of Ranalli, or what those problems are.

Because, whether analyzed alone or in combination, Ranalli and Tout fail to teach or suggest all the claimed elements, and because there would be no motivation to modify Ranalli with the disclosure of Tout as proposed by the Examiner, the Examiner has failed to make a

prima facie case of obviousness. Applicant therefore respectfully requests the Examiner to withdraw the rejection to Claim 35 under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing remarks and amendment, Applicant respectfully maintains that independent Claims 1, 6, 13, 16, 22, 28, 31, and 35 are patentably distinct over the cited art, and are in condition for allowance. Claims 2-5, Claims 7-12, Claims 14-15, Claims 17-21, Claims 23-27, Claims 29-30, Claims 32-34, which respectively depend from independent Claims 1, 6, 13, 16, 22, 28, and 31 and further define Claims 1, 6, 13, 16, 22, 28, and 31, are likewise patentably distinct over the cited art and are in condition for allowance. Applicant therefore respectfully requests withdrawal of the rejection of Claims 1-35, and requests that the Examiner allow Claims 1-35.

Request for Telephone Interview

If there are any issues that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned attorney of record at (310) 407-3461 or at the number set forth below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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